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AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: Crone

Serial No.: 10/680,678

Filing Date: October 7, 2003

Docket No.: 5164-001

Title: System and Method of Improving Customer Health, Reducing Income Tax by Charitable Gift, and Providing Hunger Relief for the Needy

Examiner: Mr. Florian M. Zeender

Group Art Unit: 3627

*Reply Brief  
to  
Entered  
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Mail Stop Appeal Brief - Patents  
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**CERTIFICATE OF MAILING**

I hereby certify that this brief is being deposited in triplicate with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 31, 2005.

*Laura Wade*  
Laura A. Wade

**REPLY BRIEF**

This Reply Brief is filed in response to the Examiner's Answer, mailed April 27, 2005.

**Grouping of Claims**

The Examiner cites to and relies on 37 CFR § 1.192(c)(7) regarding Applicant's lack of statement(s) of which claims stand or fall together. This is not the rule. 37 CFR § 41.37(c)(1), et. seq., effective September 13, 2004, governing the structure and requirements of an Appeal Brief, obviated the requirement of explicitly grouping claims, and dictates that claim groups for which separate arguments of patentability are provided, must be separately considered. See, 37 CFR § 41.37(c)(1)(vii).

Rejection under 35 USC § 101

The Examiner stated, "The Board has provided guidance with respect to this issue in previous decisions." Yet, the only previous decision to which the Examiner cites for such "guidance" is one that begins, "[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this decision ... is not binding precedent of the board.]" *Ex parte Bowman*, 61 USPQ2d 1669, 1670 (BPAI, 2001) (emphasis added).

*Arguendo*, if the Board agrees with the Examiner that the nonprecedential *Bowman* offers some legal precedent, the subject matter of *Bowman* was mathematical calculation. *Bowman* claimed a method of evaluating an intangible asset of interest by establishing certain variables and performance criteria relating thereto, scoring the performance criteria, summing the scores, and plotting the scores on a chart. The Board held, in conformance with a long line of Federal Circuit precedent,<sup>1</sup> that *Bowman*'s claim was "directed to nothing more than a human making mental computations and manually plotting the results on a paper chart," and consequently did not recite patentable subject matter.

The present invention is easily distinguished. As discussed extensively in Applicant's Appeal Brief at 7(A), p. 4-5, claim 1 recites the concrete method steps of selling a meal product at a specific price, collecting at least that price in funds, and transferring part of those funds to a charity. These method steps comprise a commercial transaction, and are not merely "a human making mental computations." The recited elements require at least the exchange of goods for money, and a subsequent transfer of funds. Claim 1 recites a method of doing business, and it is beyond question that methods of doing business are patentable subject matter under 35 USC § 101. *State*

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<sup>1</sup> *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), *Diamond v. Diehr*, 450 U.S. 175 (1981), *Parker v. Flook*, 437 U.S. 584 (1978); *Gottschalk v. Benson*, 409 U.S. 63 (1972).

*Street Bank & Trust Co. v. Signature Fin. Group Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

Rejection under 35 USC § 103 over Helbling

The Examiner has erroneously asserted (or implied, in addressing only claim 11) that the Board is free to disregard claim 1. In the Appeal Brief, Sections 8(A), 8(B) p. 11-12, 8(B) p. 12-14,<sup>2</sup> and 8(D), Applicant specifically and explicitly addressed both claims 1 and 11. Pursuant to 37 CFR § 41.37(c)(1)(vii), applicant's arguments must be considered regarding each argued claim. Section 8(C) is directed solely to claim 1.

Regarding claim 11, the Examiner argues that the prior art "has to be capable of performing the claimed function." (emphasis in original). Helbling does not disclose such a system – if it did, the rejection would be under 35 USC § 102. In making a § 103 rejection, the Examiner admitted that Helbling must be modified to recite each and every claimed limitation. That Helbling may be capable of being so modified, is not the test of obviousness. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

The fatal flaw in the Examiner's § 103 rejections is that not only does Helbling not contain any hint of a suggestion to structure a meal, transaction, and transfer of funds as recited in claims 1 and 11 – Helbling teaches away from doing so by its very structure and the price points it discloses. See Appeal Brief, Sections 8(B) p. 11-12, 8(B) p. 12-14, and 8(C). Only in hindsight, using claims 1 and 11 as a blueprint, would one of skill in the art be motivated to modify Helbling as the Examiner proposed.

The Examiner continues to construct alleged full- and reduced-portion meals in the rejection of Applicant's claims that do not conform to the clearly stated definition of those terms in Applicant's specification – which definition must control the interpretation

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<sup>2</sup> Applicant apologizes for the duplicate numbering of the arguments denoted 8(B).

those terms in Applicant's specification – which definition must control the interpretation of claim terms. MPEP § 2111.01 III. To escape this restriction, the Examiner has argued that language at p. 5, lines 18-20, admitting of variety in any specific implementation, renders the definition ambiguous. This argument is unfounded.

In particular, the Examiner has mischaracterized Applicant's arguments in the Appeal Brief as "relying" on examples given in the specification. The Examiner asserts they "are just that, '**examples**', that do not provide a clear definition of the terminology, 'reduced-portion meal product'." (all types of emphasis in original). Precisely. Applicant has never asserted that the examples provide any definition of the term "reduced-portion meal product." That term is defined at p. 4, lines 22-24: "Each reduced-portion meal product comprises the same elements as its corresponding full-portion meal product, but in reduced quantities."

Examples of different specific configurations of what constitutes a "reduced quantity" merely prove the validity of the statement at p. 5, lines 18-20, that "a wide variety of reduced-portion meal product configurations with concomitant cost and price structures and operating fees are possible," while fully complying with the provided definition of a reduced-portion meal product.

A statement that an overarching definition admits of variety in specific implementations does not render the definition moot as ambiguous. According to that logic, the variety of over 6.5 million issued U.S. patents must render the definitions of patentability in 35 USC §§ 101, 102, 103 and 112 ambiguous and hence moot – a ridiculous proposition. A broad definition – such as Applicant's definition of a reduced-portion meal product – may admit of considerable variation while remaining crystal clear: the reduced-portion meal product includes the same elements as its corresponding full-portion meal product, but in reduced quantities. None of the hypothetical reduced-portion meal products proffered by the Examiner complies with this simple, clear

definition. Consequently, the rejections relying on such hypothetical products cannot stand.

Rejection under 35 USC § 103 over Helbling in combination with Burke

The Examiner's dismissal of Applicant's arguments regarding claims 7-10 and 15-18 rely on the erstwhile requirement of a statement as to which claims stand or fall together. Under 37 CFR § 41.37(c)(1)(vii), claims argued as a group must be separately considered. Section 9 of the Appeal Brief clearly discusses separate reasons for patentability of claims 7-10 and 15-18, which arguments the Board must consider.

Conclusion

For the reasons set forth in the Appeal Brief and above, all claims being appealed herein recite patentable subject matter, and are patentably nonobvious over the cited art. Accordingly, the rejections maintained by the Examiner must be reversed.

Respectfully submitted,

**COATS & BENNETT, P.L.L.C.**

  
Edward H. Green, III  
Attorney for Applicant  
Registration No.: 42,604

P.O. Box 5  
Raleigh, NC 27602  
Telephone: (919) 854-1844

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